

Claims 15 , 17, 18, 36-42, 45-48, 75-81, 84-97, 99 and 100 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Culver (U.S. Patent No. 6,256,011). This rejection is respectfully traversed and reconsideration is respectfully requested.

Pursuant to 35 U.S.C. § 103(c), Culver cannot be used to render the pending claims obvious, since Culver was owned by the assignee of the present application at the time of filing

It is respectfully submitted that Culver cannot be used to render the claims obvious. The American Inventors Protection Act of 1999 ("AIPA") amended 35 U.S.C. § 103(c) to add that subject matter that only qualifies as prior art under 35 U.S.C. § 102(e) and that was commonly owned, or subject to an obligation of assignment to the same person, at the time the invention was made cannot be applied in a rejection under 35 U.S.C. § 103(a). Specifically, § 103(c) now states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

According to the AIPA § 4807(b), §103(c) applies to any patent application filed on or after the date of enactment, November 29, 1999. See also the Official Gazette dated December 26, 2000, which explains the U.S.P.T.O.'s current policy towards § 103(c).

Here, the present application was filed on October 2, 2000 (i.e., after November 29, 1999) so that the changes to § 103(c) made by the AIPA apply to this application. The Examiner did not indicate under which section of 35 U.S.C. 102 Culver is prior art but it would appear that the Examiner believes it to be Section (e) (Culver was filed 12/1/98, with priority to 12/3/97, and issued on 7/3/2001). Culver and the present application were also commonly owned or subject to assignment to the same person at the time that the invention of the present application was made. In this regard, the undersigned, an attorney of record states:

U.S. Patent Application No. 09/678,110 and U.S. Patent No. 6,256,011 were, at the time the invention of U.S. Patent Application No. 09/678,110 was made, owned by Immersion Corporation of San Jose, California or subject to an obligation of assignment to Immersion Corporation.

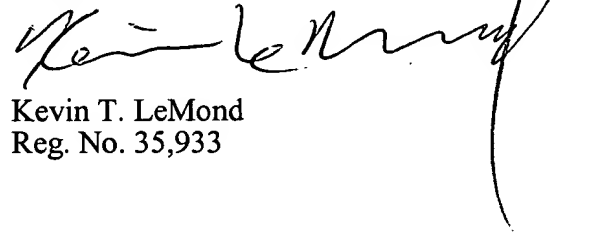
In support of this statement, copies of the assignment papers associated with U.S. Patent No. 6,256,011 (corresponding to U.S. Application No. 09/203,908) are attached as Exhibit A and copies of the assignment filed in the parent of the present application is attached as Exhibit B.

In sum, because Culver appears to only be prior art under 35 U.S.C. § 102(e) and because Culver and the present application were commonly assigned or subject to assignment to the same person at the time of the invention, Culver cannot be used to render the claims obvious pursuant to 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request that the pending obviousness rejection of record, which is based on Culver, be withdrawn.

CONCLUSION

In view of the foregoing, a Notice of Allowance is respectfully and earnestly solicited. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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